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| 09/627,725  | 07/28/2000  | Tomoko Oyabu         | 450100-02622        | 2836             |
| 20999   | 7590        | 10/24/2003           | EXAMINER            |                  |
| FROMMER LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      | HUYNH, SON P        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2611                |                  |

DATE MAILED: 10/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/627,725

Applicant(s)

OYABU ET AL.

Examiner

Son P Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 5 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Maissel et al. (US 2003/0088872 A1).

Regarding claim 5, Maissel teaches an information-receiving device (headend 15) connected to a communication terminal device (other users) by predetermined communication means (figure 10B and par. 0294), the information receiving device comprising:

program guide information storing means (intelligent agent 330) for storing beforehand program guide information indicating the contents of programs to be supplied by predetermined program supplying means (see figure 8A and paragraph 0218);

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preference information storing means (profile storing unit 370) for correlating preference information indicating the preferences of user using the communication terminal device (other users) with identification information appropriated to the communication terminal device (programs can be transmitted directly to user addresses (par. 0294), and storing the preference information beforehand (see figure 8A and par. 0244); Maissel also discloses television viewing information may be transmitted to the headend 15 via one of the telephone network and the LAN 85 or by radio frequency transmitter 101 (par. 0277 and figure 10B). The intelligent agent is operative to customize the program schedule information received from the receiving unit 120 in accordance with one of more viewer preference profiles belonging to one or more viewers and to output a program guide comprising the customized program schedule information to the display apparatus for display (see paragraph 0184+). Clearly, providing device comprises: receiving means for receiving identification information transmitted from a remote commander (apparatus 10 transmits uplink information via transmitter 101 or telephone network); searching means for reading from the preference information storing means the preference information; searching programs matching the preferences of the user from the program guide information based on the read preference information, and generating searched program guide information (customized program guide information) comprising the searched programs; and transmitting means for transmitting the searched program guide information to the remote commander (apparatus 10); and a remote commander having first transmitting/receiving means (transmitter 101/receiver 40- figure 10B) for directly exchange information between the receiving means and the

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transmitting means, and second transmitting/receiving means (telephone network 80 or LAN 85) for exchanging information via the communication terminal device and the communicating means (figure 10 and par. 0294).

Regarding claim 13, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 5, and are analyzed as discussed with respect to the rejection of claim 5.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1), and in view of Hendricks et al. (US 6,463,585).

Regarding claim 1, Maissel teaches a program guide information providing device (head end 340) connected to a communication terminal device (interface 110) via predetermined communication means; the program guide information providing device comprising:

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program guide information storing means (intelligent agent 330) for storing beforehand program guide information indicating the contents of programs to be supplied by predetermined program supplying means (see figure 8A and paragraph 0218); preference information storing means (profile storing unit 370) for correlating preference information indicating the preferences of user using the communication terminal device, and storing the preference information beforehand (see figure 8A and par. 0244); Maissel further discloses the intelligent agent is operative to customize the program schedule information received from the receiving unit 120 in accordance with one of more viewer preference profiles belonging to one or more viewers and to output a program guide comprising the customized program schedule information to the display apparatus for display (see paragraph 0184+). Clearly, the device comprises a searching means for reading from the preference information storing means the preference information; searching programs matching the preferences of the user from the program guide information based on the read preference information, and generating searched program guide information (customized program guide information) comprising the searched programs; and transmitting means for transmitting the searched program guide information to the communication terminal device. Maissel also discloses the intelligent agent 360 is operative to receive one or more viewer profiles associated with a particular site, such as site 380, and to prepare customized program schedule information intended for the particular site (paragraph 0244). However, Maissel does not specifically disclose storing identification information appropriate to the communication terminal device.

Hendricks teaches Viewer Profile database 314 includes a Set top ID file (see col. 66, line 16+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching as taught by Hendricks in order to target program to predetermined terminal device.

Regarding claim 2, Hendricks teaches receiving means (cable headend receiver 203) for receiving program supplied from program supplying means (see figure 20).

Regarding claim 3, Maissel teaches a program guide information providing system comprising a communication terminal device (interface 110) and a program guide information providing device connected by a predetermined communication means; the program guide information providing device comprising:

program guide information storing means (intelligent agent 330) for storing beforehand

program guide information indicating the contents of programs to be supplied by

predetermined program supplying means (see figure 8A and paragraph 0218);

preference information storing means (profile storing unit 370) for correlating preference

information indicating the preferences of user using the communication terminal device,

and storing the preference information beforehand (see figure 8A and par. 0244);

Maissel also discloses television viewing information may be transmitted to the headend

340 by a modem 375 (paragraph 0243+). The intelligent agent is operative to customize

the program schedule information received from the receiving unit 120 in accordance

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with one or more viewer preference profiles belonging to one or more viewers and to output a program guide comprising the customized program schedule information to the display apparatus for display (see paragraph 0184+). The display information may comprise an alert to a user of the display apparatus (paragraph 0247+ and figure 8A).

Clearly, providing device comprises: receiving means for receiving identification information (viewer information) transmitted from the communication terminal device (interface 110); searching means for reading from the preference information storing means the preference information corresponding to the identification information; searching programs matching the preferences of the user from the program guide information based on the read preference information, and generating searched program guide information (customized program guide information) comprising the searched programs; and transmitting means for transmitting the searched program guide information to the communication terminal device ; and the communication terminal device comprises: transmitting means (modem 375) for transmitting the guide information providing device (headend) the program identification information appropriated to the communication terminal device; receiving means (receive unit 120) for receiving the searched program guide information transmitted from the program guide providing device (headend); and notification means (alert 105 on the display apparatus 100) for notifying the user of received searched program guide information.

Maissel also discloses the intelligent agent 360 is operative to receive one or more viewer profiles associated with a particular site, such as site 380, and to prepare customized program schedule information intended for the particular site (paragraph



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0244). However, Maissel does not explicitly disclose identification information appropriated to the communication terminal device.

Hendricks teaches Viewer Profile database 314 includes a Set top ID file (see col. 66, line 16+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching as taught by Hendricks in order to target program to predetermined terminal device.

Regarding claim 4, Hendricks teaches receiving means (cable headend receiver 203) for receiving program supplied from program supplying means (see figure 20).

Regarding claims 9-12, the limitations of the method as claimed correspond to the limitations of the device as claims in claims 1-4 respectively and are analyzed as discussed with respect to the rejection of claims 1-4.

5. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1), and in view of Ellis et al. (US 2003/0149988).

Regarding claim 6, Maissel teaches an information receiving device as discussed in the rejection of claim 5. However, Maissel does not specifically disclose recording control means for recording to recording means programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means.

Ellis teaches recording control means for recording to recording means (storage 15-see figures 2d, 4) programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means (see par. 0013). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching of Ellis in order to allow multiple users to share programs stored as the server and reduce space at the terminal device.

Regarding claim 14, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 6, and are analyzed as discussed with respect to the rejection of claim 6.

6. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1) and in view of Darbee et al. (US 6,130,726).

Regarding claim 7, Maissel teaches a operating system wherein a communication terminal device (remote control 111) and an information receiving device (head end 15) are connected via predetermined communication (figure 10B) wherein the information receiving device comprising:

program guide information storing means (intelligent agent 330) for storing beforehand program guide information indicating the contents of programs to be supplied by predetermined program supplying means (see figure 8A and paragraph 0218);

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preference information storing means (profile storing unit 370) for correlating preference information indicating the preferences of user using the communication terminal device (other users), and storing the preference information beforehand (see figure 8A and par. 0244); Maissel also discloses television viewing information may be transmitted to the headend 15 via one of the telephone network and the LAN 85 or by radio frequency transmitter 101 (par. 0277 and figure 10B). The intelligent agent is operative to customize the program schedule information received from the receiving unit 120 in accordance with one of more viewer preference profiles belonging to one or more viewers and to output a program guide comprising the customized program schedule information to the display apparatus for display (see paragraph 0184+). Clearly, providing device comprises: receiving means for receiving identification information transmitted from a remote commander (apparatus 10 transmits uplink information via transmitter 101 or telephone network); searching means for reading from the preference information storing means the preference information; searching programs matching the preferences of the user from the program guide information based on the read preference information, and generating searched program guide information (customized program guide information) comprising the searched programs; and transmitting means for transmitting the searched program guide information to the remote commander (apparatus 10) ; and a remote commander having first transmitting/receiving means (transmitter 101/receiver 40- figure 10B) for directly exchange information between the receiving means and the transmitting means. Maissel further discloses each member of family of the user may select corresponding

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agent by using a different key on the remote control 111 or by using a different remote control (par. 0323). Inherently, the terminal device (remote control 111) comprises transmitting means for transmitting to the remote commander (apparatus 10) the identification information appropriate to the communication terminal device (remote command 111). However, Maissel fails to disclose apparatus 10 comprise a second transmitting means for exchanging information via remote control 111 and communicating means, the remote control 111 comprises: receiving means for receiving the searched program guide information transmitted from the apparatus 10, and notifying means for notifying the user of the received searched program guide information.

Darbee discloses remote control that comprises transceiver 48 or (receiver 34/transmitter 35) for receiving program guide from a set top box and transmits command to the set top box (see figure 2 and col. 3, line 31+). The received program guide information is displayed the received program guide on LCD 14 (see figures 2, 5A). Thus, the remote commander (set top box) comprises a second transmitting means for transmitting program guide to the communication terminal device (remote control 10) and the communication terminal device comprises receiver 35 or transceiver 40 reads on the receiving means and the LCD 14 reads on the notification means. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching as taught by Darbee in order to allow user

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to search a program on the EPG without interrupting other viewers watching program on the screen of set top box.

Regarding claim 15, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 7, and are analyzed as discussed with respect to the rejection of claim 7.

7. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1), in view of Darbee et al. (US 6,130,726); and further in view of Ellis et al. (US 2003/0149988).

Regarding claim 8, Maissel in view of Darbee teaches an information receiving device as discussed in the rejection of claim 7. However, neither Maissel nor Darbee specifically disclose recording control means for recording to recording means programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means.

Ellis teaches recording control means for recording to recording means (storage 15-see figures 2d, 4) programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means (see par. 0013). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel and Darbee to use the teaching of Ellis in order to allow

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multiple users to share programs stored as the server and reduce space at the terminal device.

Regarding claim 16, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 8, and are analyzed as discussed with respect to the rejection of claim 8.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herz et al. (US 6,088,722) teaches system and method for scheduling broadcast of and access to video programs and other data using customer profiles.

Sumita et al. (US 6,581,207) teaches information filtering system and method.

Herz (US 6,407,779) teaches method and apparatus for an institute universal remote control system.

Ismail et al. (US 6,614,987) teaches television program recording with user preference determination.

Blahut et al. (US 5,663,756) teaches restricted access remote control unit.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.

Son P. Huynh  
October 14, 2003

  
ANDREW FAILE  
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